

REMARKS:Claims 9-13, 20-22, 24, 27, 30, 31, 33 and 36

Claims 9-13, 20-22, 24, 27, 30, 31, 33 and 36 have been rejected under 35 USC 102(e) as being anticipated by Sato (US6563678).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 9-20, 23, 24, 27-29, 32, 33 and 36-38 prior to the effective date of Sato (Oct. 6, 1999). Per MPEP 706.02(b), Applicant may overcome a 35 U.S.C. 102(e) rejection by showing completion of the invention by applicant prior to the effective date of the reference. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 9-13, 20, 24, 27, 33 and 36 based on Sato.

Regarding claims 21, 22, 30 and 31, the limitations of claims 21, 22, 30 and 31, while not specifically shown in Exhibit A of the accompanying Declaration, would have been obvious to one skilled in the art, as evidenced by the disclosure of "insulative" gap layers in Exhibit A of the attached Declaration. Applicant also notes that in Section 7 of the Office Action, the Examiner indicates that selection of materials is "an obvious matter of design choice." In the present case, it was well known to use alumina and aluminum oxide to form insulative layers at the time Exhibit A was created. As noted in MPEP 706.15, even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. *In re Spiller*, 500 F.2d

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1170, 182 USPQ 614 (CCPA 1974).

In the instant case, the basic inventive concept is fully disclosed in the accompanying Declaration. Claims 21, 22, 30 and 31 merely define known types of insulating material known at the time of invention. Accordingly, the limitations of claims 21, 22, 30 and 31 are believed to be inherently present in Exhibit A of the attached Declaration, and thus predate Sato.

Claim 14

Claim 14 has been rejected under 35 USC 103(a) as being unpatentable over Sato in view of Sasaki (US6729012).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claim 14 prior to the effective date of Sato (Oct. 6, 1999). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by Applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 14 based in part on Sato.

Claim 15

Claim 15 has been rejected under 35 USC 103(a) as being unpatentable over Sato in view of Yazawa et al. (US6751071).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claim 15 prior to the effective date of Sato (Oct. 6, 1999). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by Applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 15 based in part on Sato.

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Claims 23 and 32

Claims 23 and 32 have been rejected under 35 USC 103(a) as being unpatentable over Sato in view of Sasaki (US6598289).

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 23 and 32 prior to the effective date of Sato (Oct. 6, 1999). Per MPEP 715.02, Applicants may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by Applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 23 and 32 based in part on Sato.

Claims 25, 26, 28, 29, 34, 35, 37 and 38

Claims 25, 26, 28, 29, 34, 35, 37 and 38 have been rejected under 35 USC 103(a) as being unpatentable over Sato.

Submitted herewith is a declaration under 37 CFR 1.131 establishing invention of the subject matter of rejected claims 28, 29, 37 and 38 prior to the effective date of Sato (Oct. 6, 1999). Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 28, 29, 37 and 38 based on Sato.


Regarding the limitations of claims 25, 26, 34 and 35, per MPEP 715.02, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

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In the present case, the core invention is disclosed in Exhibit A of the Declaration. The rejection merely states the materials claimed in claims 25, 26 34 and 35 are "obvious design choices." Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 25, 26, 34 and 35 based in part on Sato.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. SJO920010068US2).

Respectfully submitted,

By:   
Dominic M. Kotab  
Reg. No. 42,762

Date: 5/5/06

Zilka-Kotab, PC  
P.O. Box 721120  
San Jose, California 95172-1120  
Telephone: (408) 971-2573  
Facsimile: (408) 971-4660

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